REMARKS

This communication is in response to an Office Action dated March 17, 2004. Claims 1, 3-5, 7-11 and 20 are now present in this case. The applicants wish to express their appreciation to the Examiner for vacating the finality of the previous Office Action.

In the present Office Action, claims 1, 3, 4, 7-11 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of three separate references. Specifically, the claims are rejected as unpatentable over U.S. Patent No. 4,541,227 to Coad et al. combined with Swiss U.S. Patent No. CH 187,705 to Christoffel combined with German Patent No. DE 3,416,710 to Lissner. For the reasons discussed below, the applicants kindly disagree with the assessment of these references and their applicability to the claimed invention.

The claimed invention is directed to multi-layer paper bales for use in an automated bale loading apparatus. Coad is the only reference in which bags are intended for an automated operation. As such, Coad serves as an excellent illustration of all of the problems faced by designers attempting to design a bag for use in an automated process. The Office Action correctly notes that Coad "does not teach an aperture in the back panel in a cutaway portion in the front panel exposing the aperture." Indeed, Coad teaches directly away from the claimed invention and follows a conventional approach for bags in an automated process. Specifically, the bags in Coad are flat folded and stacked in a magazine 12 formed by a substantially rectangular frame 18 with dimensions slightly greater than the dimension of the bags. (See column 2, lines 52-58 and Figure 1.)

The process of extracting, opening, and loading a bag is illustrated in Figures 3-8 of Coad and described in Coad at column 5, line 45—column 6, line 23. Throughout this process, it should be noted that the bags in Coad are essentially lying on one side with the opening facing toward the right in Figures 3-7. A single bag is extracted and partially opened, as illustrated in Figure 5. Multiple bags of prepackaged products are inserted into the opened bag, as illustrated in Figures 6 and 7 of Coad. As

noted above, at all times, the bag is in the horizontal position (*i.e.*, lying on its side). In Figure 8, the entire drop table on which the open bag has been resting tilts, as illustrated in Figure 8, to discharge the packed bag from the apparatus. Thus, the entire design in operation in the system of Coad teaches away from vertical orientation of bags and requires no hole or aperture. One skilled in the art looking at Coad would orient bags horizontally and would use a magazine, as is common in the art. Accordingly, one skilled in the art would not seek to combine the references in the manner suggested in the Office Action.

The Office Action states that Christoffel teaches that it is known to provide a paper bag with an aperture 4 in the back panel and a cutaway portion 5 in the front panel thereby exposing the aperture. This limited recitation of Christoffel ignores the overall teaching of the reference. Christoffel is a 1937 Swiss patent directed to a technique for unfolding a bag as it is manually torn from a nail. (See page 1, paragraph 1.) To accomplish this goal, each bag has a vertical crease 6 extending from the very bottom of the bag directly through the center of the hole 4. To accomplish the opening process, Christoffel states that the bags have been bundled together and folded at an angle and that "to retain their shape, it is important to hang them on a nail over a three-sided block (8) on the wall or over the edge of a piece of furniture, etc." (See page 2, paragraph 1.) To produce the opening effect, "the paper bag is grasped by the upper edge of the bottom (1) and pulled downwards at an angle as is illustrated in Figure 4." (See page 2, paragraph 2.)

Christoffel teaches directly away from the claimed invention by disclosing a bag that must be creased and folded along a vertical line to operate correctly. Those skilled in the art will recognize that a bag folded in such a manner will not function properly in an automating bagging operation, which is the claimed use of the bale bags of the present invention. It should also be noted that the approach by Christoffel, using creased and folded bags is in direct opposition to the teachings of Coad which uses "flat-folded bale bags." (See Abstract.) In a conventional automated bag-filling apparatus, such as that shown in Coad, bags are flat-folded and loaded in a magazine.

Other machines use plastic bags supplied in a roll. In each of these examples, the bag to be extracted is flat and not creased in the manner required by Christoffel.

Furthermore, those skilled in the art will appreciate that the vertical crease extending directly through the hole 4 weakens the bag in the area above the hole near the top of the bag thus increasing the likelihood of premature tearing of the bag, resulting in jammed equipment. Christoffel is clearly directed to a manual bag mounting and removal process and is totally unsuited for use with an automated bale-filling apparatus, as recited in, by way of example, claim 1 of the present invention.

The Office Action correctly states that neither Coad nor Christoffel suggest a multilayered paper bale for shipping bulk quantities of potatoes, as recited in, by way of example, claim 1 of the present invention. The Office Action combines Lissner with Coad and Christoffel to reach the conclusion that the claimed invention is obvious. The Office Action states that Lissner "teaches it is known to use multiple paper layers to construct a bale bag." It should be noted that Lissner is a German language document with only the abstract being provided in English. However, at no point does the English language abstract mention any application to an automated operation. Furthermore, the Figures in Lissner do not teach or suggest any use in an automated operation. Lissner discloses a multilayer bag in which succeeding layers project beyond the highest point of the previous layer, as can be seen in Figures 1 and 2 of Lissner. Lissner also discloses multiple incisions A4, A5 and A6 in the multiple layers to allow the bag to be tightly folded and sealed. (See Abstract.) One of ordinary skill in the art would quickly recognize that the multiple incisions in the bag of Lissner make it unsuitable for use in an automated potato bale filling apparatus. In accordance with the Office Action, the bag of Lissner would have to be modified to have a hole somewhere in the multiple layers of the top of the bag in Lissner in order to achieve the claimed invention. Because of the multiple layers and incisions in those multiple layers, a hole would further weaken the entire structure and be totally unsuitable for operation even as a bag. A hole in the top of the bag may also degrade the operation of the bag of Lissner for tight folding and sealing. Accordingly, Lisner cannot be modified in the way suggest in the Office Action. The multilayered approach of Lissner, with offset

layers and incisions in each of the offset layers makes it unsuitable for use in an automated operation.

It appears that the Office Action utilizes the claims of the present invention as a road map to combine three different references in an effort to find the present invention obvious. However, the references are unlikely to be combined by one of skilled in the art to achieve the claimed invention. Coad is the only reference in which a bag is used in an automated filling apparatus, which is a requirement of independent claims 1 and 20. However, as noted above, Coad also serves to illustrate the difficulty in designing a bag for use in an automated operation. Coad mounts the bags horizontally in a magazine and maintains the bags in a horizontal configuration throughout the loading process. Coad has absolutely no need for "an aperture in the back panel proximate the top portion with the back panel having a continuous perimeter surrounding the aperture," as cited in claim 1 of the present invention. One of ordinary skill in the art knowing the teachings of Coad would feel no need to modify the bag in Coad by placing an aperture in the top portion because the whole approach taken by Coad teaches away from vertical orientation of bags and thus the need for a hole in the top portion of the bag. The manually removed creased bag of Christoffel is in direct opposition to the flat-folded bags of Coad used in an automated process. The references cannot be combined in the way suggested in the Office Action because the bags are in a totally different configuration (*i.e.*, flat bags in a horizontal orientation in an automated magazine dispenser in Coad and creased bags mounted on a three-sided block in a vertical orientation for manual removal in Christoffel). There is no suggestion to combine the references in the manner suggest in the Office Action and all teachings within the two references teach away from such a combination.

The inoperability of the combination of Coad and Christoffel is further compounded by the multi-layered bag of Lissner. The multiple layers of Lissner extend above each other and do not provide a suitable location for a hole. Any hole in the top central portion would have to extend through multiple layers thus defeating the purpose of Lissner of a tightly folded and sealed bag. A hole in the multiple layers, when combined with the incisions in the multiple layers, cause an unacceptably weak

structure for use in an automated operation. Adding an aperture through multiple layers is not taught or suggested by Lissner or any of the references cited in the Office Action. One of skill in the art would not combine the multiple overlapping layers in the bag of Lissner in the way suggested in the Office Action. Accordingly, claims 1, 3, 4, 7-11 and 20 are clearly allowable over the cited references.

Claim 5 is also allowable in view of the fact that it depends from claims 1, and further in view of the recitation within the claim.

The applicants have made a good faith effort to place all claims in condition for allowance. The remarks provided herein clearly point out the ineffectiveness and inoperability of the combination of references cited in the Office Action. Not only are the references unlikely to be combined in the manner suggested in the Office Action, the references are physically incapable of combination in the manner suggested in the Office Action. The applicants kindly request reconsideration and the allowance of the claimed subject manner. If questions remain regarding this application, the Examiner is invited to contact the undersigned at (206) 628-7640.

Respectfully submitted,
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